

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of)
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Peter J. Potrebic)Art Unit
Serial No.: 09/781,110)2623
Filed: February 9, 2001)
Confirmation No. 2976)
For: SYSTEMS AND METHODS)
FOR RECORDING)
FRAGMENTED PROGRAMS)
Examiner: Annan Q. Shang)
Customer No.: 47973)

REPLY BRIEF OF APPELLANTS

VIA eFILE Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On March 8, 2007, the Examiner mailed an Examiner's Answer to Appellant's timely-filed Appeal Brief. This Reply Brief is being filed under the provisions of 37 C.F.R. § 41.41. This brief is being filed on Monday, May 7, 2007 and is therefore timely under 37 C.F.R. § 41.41.

I. INTRODUCTION

Appealed claims 1-5, 9-23, 25, 26, and 28-35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood *et al.* (Application 2003/0044165) in view of Kundson *et al.* (Application 2005/0273819), and further in view of Abbott *et al.* (U.S. Patent No. 5,973,679). The Examiner's Answer to the Appeal Brief concedes that Examiner's argument in the Final Office Action mailed April 6, 2006 ("Office Action") that the prior art "inherently" disclosed claimed elements was misplaced. However, the Examiner's Answer does not address the specific difference in the unique identifiers recited in claims 1 and 21, as pointed out in the Appeal Brief. Finally, the Examiner has simply restated the objections and citations to the prior art contained in the Office Action without providing any substantive rebuttal to the arguments in the Appeal Brief distinguishing the claims from the cited prior art. For these reasons, as set forth in detail below, the Examiner's rejections should respectfully be withdrawn and the claims allowed.

II. ARGUMENT

A. *The Examiner Has Failed to Cite Prior Art Teaching the Limitation of a Unique Identifier that Is Distinguished from a Program Title*

As set forth in the Appeal Brief, each of the pending claims 1-5, 9-23, 25, 26, and 28-35, require a method that uses a unique identifier in the EPG data that "is distinguished and independent from a program title." The Examiner has failed to cite any prior art reference teaching this limitation.

1. *The Examiner Concedes that the Examiner Erroneously Relied on the Doctrine of Inherency to Argue that Wood Teaches a "Unique Identifier that Is Distinguished from a Program Title"*

In the Office Action, the Examiner states that Wood "inherently" discloses a unique identifier in the EPG data that is distinguished and independent from a program title. [Office

Action, at p. 3.] Having addressed the Examiner’s argument on inherency in the Appeal Brief, the Examiner now concedes that “Wood as modified by Knudson, fail to explicitly teach the claimed ‘a unique identifier . . . is distinguished and independent from the a [sic] program title . . .’” [Examiner’s Answer, at p. 6.] Thus, the Examiner no longer argues that Wood teaches the limitation of a unique identifier in the EPG data that “is distinguished and independent from a program title.”

2. Abbott Does Not Disclose a “Unique Identifier that Is Distinguished from a Program Title”

Having conceded that Wood does not disclose the claimed unique identifier that “is distinguished and independent from a program title,” the Examiner argues that Abbott teaches this limitation. [Examiner’s Answer, at p. 6.] In support of this argument, the Examiner cites to Abbott at col. 4, line 53 – col. 5, line 3, col. 7, lines 12-20, and col. 20, line 66 – col. 21, line 11. [*Id.*] These citations to Abbott are precisely the same citations that the Examiner relied on in the Office Action to argue that Abbott teaches that “a series is assigned a unique series identifier or series ID when stored.” [Office Action, at p. 5.] Applicant addressed each of these citations to Abbott in at pages 12-15 of the Appeal Brief, explaining that the “series” and “unique identifier” of Abbott are in no way related to the series and unique identifier of the claimed invention. In summary, Abbott teaches a “series” consisting of segments of a single broadcast, each of those segments of the same broadcast being assigned a “unique series identifier.” [See Abbott, at 7:21-31; Appeal Brief at pp. 12-15.] Nowhere does Abbott teach that the “unique series identifier” identifies *the program* as *related to a category* of programs as required by claim 1. Nowhere does Abbott teach that the *same* “unique series identifier” is used with *different programs* to identify them as related to the same category, which also is required by claim 1. The Examiner does not offer a single substantive rebuttal to these arguments in the Appeal Brief, and has

therefore tacitly conceded the same. Because the “unique identifier” of Abbott is not the same between any program, Abbott does not teach a unique identifier for the fragments of a fragmented program that also is “distinguished and independent from a program title” as required by the claims. Consequently, the Examiner’s rejections should respectfully be withdrawn and the claims allowed.

B. *The Examiner Has Failed to Cite Prior Art Teaching the Limitation of a Fragmented Program List of the Fragmented Programs Corresponding to a Selected Category that Is Scheduled to Be Displayed During a Specific Period of Time and Wherein the EPG Data Is Used to Identify the Displayed Fragmented Program as Required by Claims 1-5, 9-20, 26, and 28-35*

Claim 1, and depending claims 2-5, 9-20, 26, and 28-35, require that the method, upon receiving a viewer’s selection of one of the categories, must “identify[] with electronic program guide data *each of one or more fragmented programs that corresponds to the selected category* and that is scheduled to be displayed during a specific period of time” and “*display[] in a fragmented program list*, each of the identified one or more fragmented programs corresponding to the selected category, wherein the fragmented program list *only includes the identified one or more fragmented programs.*” Significantly, this limitation requires the method to generate and display a list that includes *only* those identified fragmented programs. The Examiner has not identified any prior art reference that teaches or suggests a method or system that generates and displays such a “fragmented programs list.”

The Examiner argues in the Office Action that Knudson teaches the claimed fragmented programs list, citing to Knudson at figs. 4-5, 10-12, page 4 [0050-0051], [0083-0084] and [0088-0091]. [Office Action, at p. 4.] In pages 15-18 of the Appeal Brief, the Appellant addresses each of these passages cited by the Examiner, explaining in detail why these passages do not teach the fragmented programs list. The Examiner does not attempt to rebut any of these substantive arguments. Instead, the Examiner’s Answer simply contains a one-sentence

statement that Knudson teaches the limitation, and cites the exact same passages contained in the Office Action that were distinguished by the Appeal Brief. Because the Examiner has offered no substantive rebuttal of Appellant's arguments that Knudson does not teach the claimed fragmented programs list, the Examiner has effectively conceded this point. Consequently, the Examiner's rejections based on Knudson should respectfully be withdrawn.

C. *The Examiner Has Failed to Cite Prior Art Teaching the Limitation of a Unique Identifier such that "Each Fragment Corresponding to the Fragmented Program Grouping Has a Same Unique Identifier in a Grouping of Fragmented Programs Distinguished from a Program Title" as Required by Claims 21-23 and 25*

Independent claim 21 and dependent claims 22, 23 and 25 require that "each fragment corresponding to the fragmented program grouping has a same unique identifier in a grouping of fragmented programs distinguished from a program title." This unique identifier recited in claim 21 is different from the unique identifier recited in claim 1. Specifically, claim 1 recites a unique identifier to determine which fragmented programs are related to a selected category. Claim 21 recites a unique identifier to determine which fragments are related to a selected fragmented program. Thus, while the concept of using unique identifiers is similar in claims 1 and 21, these elements are not the same. [See Appeal Brief, at pp. 8 and 19-20.] The Examiner does not dispute that these unique identifiers are not the same, and yet does not address the differences of these unique identifiers in the Examiner's rejection of claims 1 and 21.

The Examiner, however, has failed to address the unique identifier recited in claim 21 separately from that of claim 1. Instead of addressing the specific unique identifier recited in claim 21, the Examiner instead groups this unique identifier with that recited in claim 1 and argues them together. Because the Examiner has failed to argue that the unique identifier of claim 21 is found is anywhere in the prior, independent claim 21 and claims 22, 23 and 25

depending therefrom are allowable, and the Examiner's rejection of these claims should be withdrawn.

D. *The Examiner's Argument that an Obviousness Rejection Can Not Be Overcome "by Attacking References Individually Where the Rejections Are Based on Combinations of References" Is Misplaced*

The Examiner's argument that an obviousness rejection can not be overcome "by attacking references individually where the rejections are based on combinations of references." [Examiner's Answer, at p. 7,] is misplaced and not applicable to the facts and arguments of the present case.

The Examiner cites to *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), for the proposition that an obviousness rejection can not be overcome by attacking individual references where the rejections are based on combinations of references. [Examiner's Answer, at p. 7.] These cases are inapposite to the present case.

In *Keller*, the claims were for a cardiac pacer that used a digital timing device. 642 F.2d at 416. In *Keller* the examiner rejected the claims over two references that disclosed cardiac pacers that used an R-C timing device in view of another reference, Walsh, that disclosed a digital timing device used in a heart stimulator, as opposed to a cardiac pacer. *Id.* at 425. The applicant argued that the examiner's rejection was erroneous because Walsh did not disclose a digital timing device in a cardiac pacer and did not contain a suggestion to combine the digital timing device of Walsh with a cardiac pacer. *Id.* The CCPA rejected this argument, holding that "one cannot show non-obviousness by attacking references individually *where, as here, the rejections are based on combinations of references.*" *Id.* at 426. In other words, the applicant in *Keller* could not overcome the obvious rejection by arguing that Walsh did not disclose a

cardiac pacer because that element was supplied by the other two references cited by the examiner.

In *Merck & Co.* the claimed invention was for using the drug amitriptyline as an antidepressant. The examiner rejected the claims as obvious over prior art disclosing the use of imipramine, a related drug, as an antidepressant in view of another reference, Peterson. The only difference between amitriptyline and imipramine is that amitriptyline has an unsaturated carbon in the central ring and imipramine has a nitrogen atom in the center ring. Peterson taught that when a nitrogen atom located in the center ring is replaced by an unsaturated carbon in otherwise identical chemicals, that the two chemicals very strongly exhibited the same properties. The CCPA found the applicant's argument that the Peterson reference taught away from the claimed invention "untenable" because Peterson, when read not in isolation but in combination of the other prior art, teaches "that the interchange of the nitrogen and the unsaturated carbon atoms is isosteric and compounds so modified are expected to possess similar biological properties." *Id.* at 1097-98. Thus, the court upheld the obviousness rejection in *Merck & Co.* because the court found that Peterson taught that amitriptyline would behave similarly to imipramine, thereby rejecting the applicant's arguments regarding the Peterson reference.

In the present case, however, the Examiner argues that Abbott teaches a unique identifier that "is distinguished and independent from a program title," and that Knudson teaches fragmented program list. [Examiner's Answer, at pp. 5-6.] The Examiner cites to no other references to show that these elements were known or obvious in the prior art. Indeed, the Examiner expressly states that the other references of record do not teach these elements, either alone or in combination. [Examiner's Answer, at p. 5 ("Wood . . . fails to explicitly teach . . . a same unique identifier and that is distinguished from a program title."), and p. 6 ("Wood as

modified by Knudson, fail to explicitly teach the claimed ‘a unique identifier . . . is distinguished and independent from the a [sic] program title . . .’.”).] Because the Examiner relies solely on these references to show that these elements are taught in the prior art, the *Keller* case is inapposite to the present case and the Appellant may overcome the rejection by showing that the elements are not found in Abbott and Knudson. *See Keller*, 642 F.2d at 427 (“But one cannot show non-obviousness by attacking references individually where, as here, the rejections *are based on combinations of references.*” (emphasis added)).

Appellant has demonstrated above and in the Appeal Brief that, in fact, Abbott and Knudson do not teach these elements. Because the Examiner provides no substantive argument in response to Appellant’s arguments regarding Abbott and Knudson, the Examiner has conceded that the Appellant’s explanations of the Abbott and Knudson references are correct. Consequently, *Merk & Co.* is inapposite to the present case. In other words, Applicant does not argue that the Examiner improperly combined Wood, Abbott and Knudson or that these references cannot be combined. Instead, Applicant has argued that Abbott and Knudson fail to teach or suggest the limitations and methods that the Examiner claims they teach. Consequently, Applicant’s arguments are both proper and sufficient to overcome the Examiner’s rejections of the pending claims. Consequently, the Examiner’s rejections should respectfully be withdrawn.

III. CONCLUSION

For the foregoing reasons, and the additional reasons set forth in the Appeal Brief, Appellant respectfully requests the Board to overturn the Examiner's rejections of the appealed claims 1-5, 9-23, 25, 26, and 28-35 and to allow these pending claims as presently written.

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Dated May 7, 2007.

Respectfully submitted,



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